

to the claims should not use square bracketing and/or underlining to avoid confusion during printing. See Office Action at 2. Applicant has noted the Examiner's suggestion, and will strive to avoid creating confusion in any future amendments.

III. Rejections Under 35 U.S.C. § 103(a)

A. Henkel in view of Tsujino

Claims 1-27, 30-34, and 37-56 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Henkel (WO 92/13824, hereinafter "Henkel") in view of Tsujino et al. (US 4,961,925, hereinafter "Tsujino"), for the reasons set forth in the Office Action at pages 2-5. Applicant respectfully traverses this rejection.

In rejecting claims under 35 U.S.C. § 103(a), the Office has the initial burden of constructing a *prima facie* case of obviousness. See MPEP § 2142. As part of that *prima facie* case, the Examiner must show, among other things, that "the prior art reference (or references when combined) . . . teach or suggest all the claim limitations." *Id.* at § 2143. Applicant respectfully contends that Henkel in view of Tsujino fails to teach or suggest all claim limitations for at least the following reason.

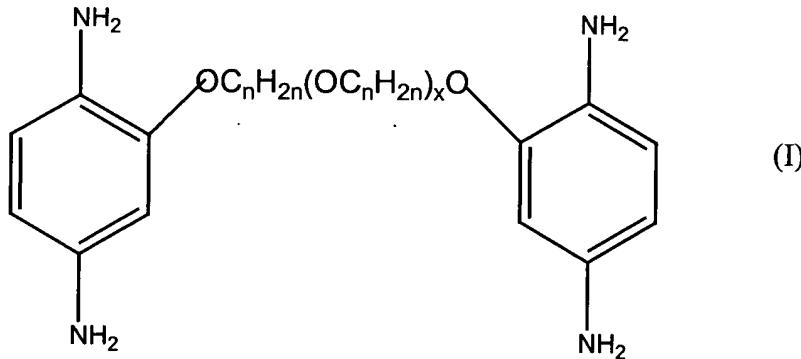
Claim 1 of the present application recites: "A composition for oxidation dyeing of keratin fibers, comprising: at least one first oxidation base chosen from 1,8(bis-2,5-diaminophenoxy)-3,5-dioxaoctane . . ." Applicant agrees that Henkel recites "1,8-Bis-(2,5-diaminophenoxy)-3,5-dioxaoctan-tetrahydrochlorid[e]." Henkel at 7, line 3. However, Applicant points out that Henkel does not teach or suggest this compound to one of ordinary skill in the art. The skilled artisan reading Henkel would readily see that

LAW OFFICES

FINNEGAN, HENDERSON,
FARABOW, GARRETT
& DUNNER, L.L.P.
1300 I STREET, N.W.
WASHINGTON, D.C. 20005
202-408-4000

this is a typographical error, and that line 3 of page 7 should read: "1,8-Bis-(2,5-diaminophenoxy)-3,6-dioxaoctan-tetrahydrochlorid[e]." This error is made plain by the recitation, after the compound name, "Formel I, n = 2, x = 2)." When n = 2 and x = 2, the compound of formula I is the 3,6-dioxaoctane, not the 3,5-dioxaoctane. Moreover, Henkel's synthesis uses "1,8-Bis-(5-nitro-2-aminophenoxy)-3,6-dioxaoctan," further demonstrating the typographical error on line 3. See *id* at line 5 (emphasis added.). The synthesis described in Example 1.1 would not convert the nitro-containing 3,6-dioxaoctane starting material into the 3,5-dioxaoctane recited in line 3.

Thus, nothing in Henkel's disclosure would teach or suggest the 3,5-dioxaoctane compound to one of ordinary skill in the art. Henkel's formula I is shown below:



where n = 2 or 3 and x is a whole number from 1-3. To fit the 3,5-dioxaoctane compound into Henkel's formula I, n would have to be 2, 1, and 3, all in the same molecule. Nothing in Henkel teaches that n can vary at different places in the same

molecule. Moreover, nothing in Henkel teaches or suggests that n can be 1. Thus, one of ordinary skill in the art would read Henkel to exclude the erroneously-recited 3,5-dioxaoctane from its disclosure.

Even if the combination of Henkel with Tsujino were justifiable, which Applicant asserts it is not, Tsujino does not remedy the shortcoming of Henkel's teaching. Tsujino is relied upon to teach dielectron reducing oxidases, conventional oxidation dyes such as p-phenylenediamine, and couplers such as 2-methyl-5-(2-hydroxyethylamino)-phenol. See Office Action at 3. However, Tsujino does not teach or suggest Applicant's claimed first oxidation base. Nor does Tsujino teach or suggest modifying Henkel's formula I to obtain Applicant's claimed first oxidation base. Thus the combination of Henkel and Tsujino fail to teach or suggest even the first claim limitation, and for at least this reason, the rejection should therefore be withdrawn.

B. Andrillon in view of Henkel

Claims 1-7, 9-13, 15-38, 41-53, and 55-56 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Andrillon et al. (US 4,065,255, hereinafter "Andrillon") in view of Henkel. Andrillon is relied upon to teach compositions for dyeing hair which contain at least one coupler and at least one oxidation base, with the possibility for including additional oxidation bases, such as those of Henkel. See Office Action at 5-7. Applicant respectfully traverses this rejection for at least the following reason.

As pointed out by the Examiner, "Andrillon does not teach the claimed first oxidation base 1,8-bis(2,5-diaminophenoxy)-3,6-dioxaoctane [sic, 1,8-bis(2,5-diaminophenoxy)-3,5-dioxaoctane]." Office Action at 6 (emphasis added). In light of the discussion

Serial No. 09/335,742
Attorney Docket No.: 5725.0429

above, neither Andrillon nor Henkel teach or suggest all claim limitations of the presently claimed invention. Therefore, for at least this reason, this rejection should be withdrawn.

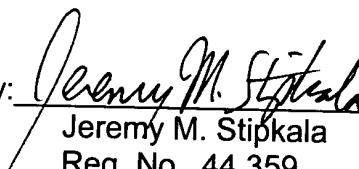
CONCLUSION

Applicant believes that the rejections should be withdrawn in light of the above remarks. All claims are now in condition for allowance. An early and favorable action is respectfully requested.

If an extension of time is necessary to enter this Amendment, please grant such extension and charge any required fees therefor to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

By: 
Jeremy M. Stipkala
Reg. No. 44,359

Dated: October 31, 2000

LAW OFFICES

FINNEGAN, HENDERSON,
FARABOW, GARRETT
& DUNNER, L.L.P.
1300 I STREET, N.W.
WASHINGTON, D.C. 20005
202-408-4000